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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,620	01/09/2002	Jason C. Gilmore	47079-0129	4385
30223	7590	10/03/2006	EXAMINER	
JENKENS & GILCHRIST, P.C. 225 WEST WASHINGTON SUITE 2600 CHICAGO, IL 60606			MOSSER, ROBERT E	
			ART UNIT	PAPER NUMBER
			3712	

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/042,620	GILMORE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Robert Mosser	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 June 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 32 and 33 is/are allowed.
- 6) Claim(s) 1,3,8-11,13 and 18-31 is/are rejected.
- 7) Claim(s) 2,4-7,12 and 14-17 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 January 2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.                    6) Other:

**DETAILED ACTION**

♦

*In response to the RCE dated August 16<sup>th</sup>, 2006.*

**Claims 1-33 are pending.**

♦

***Terminal Disclaimer***

The Terminal Disclaimer submitted June 16<sup>th</sup>, 2005 has been received and was approved.

***Drawings***

Corrected drawings were received and entered on June 16<sup>th</sup>, 2005.

***Claim Objections***

Claims 4 and 5 are objected to because of the following informalities:

Claims 4 and 5 include the language "...at least one the awarded..." for clarity this should read "...at least one of the awarded...". Appropriate correction is required.

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 16<sup>th</sup>, 2006 has been entered.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 8-9, 11, 13, and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Moody et al (US 5,976,016).

Regarding at least claims 1, 3, 8, 11, 13 and 18. Moody et al discloses a multi-line slot machine method including the receiving of wagers from players, displaying to the player on a first row of the slot machine a plurality of symbols, allowing the player to select which of the symbols to hold, and generating random replacement symbols for the symbols not held, and awarding a prize to the player according to the symbols and the pay table (Figures 1-3 & Col 1:33-48). Thus, in response to a wager the player selects the symbols to hold and the award is determined by the combination of these selected and adjacent non-selected symbols along the pay line providing the respective reward outcomes in accordance with the pay table. This correlates to at least the

displaying of a plurality of selectable elements, each one of the plurality of selectable elements being associated with a corresponding one of a plurality of respective outcomes wherein the Selectable element is the symbol hold indicator for each respective column of elements and the respective outcomes are represented with the respective game symbols shown in figure 1.

Applicant's amendments to claims 1, and 11, incorporate a first and second outcome wherein the first outcome is distinct from the second outcome. Under the present interpretation this correlates to a first outcome of a star (Elm 313) and the second outcome of a crescent moon (Elm 354) as shown in figure 3 of Moody. The first element of the 3<sup>rd</sup> column (when the columns of the respective figure are counted sequentially starting left-hand side of the figure) contained outcome of a star (Elm 313) and was selected by the player through the use of a hold feature while the second outcome was associated with the second element was associated with the 4<sup>th</sup> column and yields a second outcome of a crescent moon. These symbols are distinct from one another in so much as they are not the same symbol and do not overlap one another in their particular placement.

Regarding at least claims 9 and 19, Moody et al teaches the display of a plurality of selectable elements in a matrix including a plurality of rows and columns and wherein

at least one of the non-elected elements for which the outcome is awarded includes a plurality of the non-selected elements adjacent to the selected element (Figures 1-3).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moody et al (US 5,976,016) as applied to claims 1 and 11 above, and further in view of Schneider et al (US 6,089,976).

Moody et al is silent as to the use of an animated pattern encompassing the selected element in response to the selection. Schneider et al teaches the use of an animated pattern for the purpose of removing all of the elements that have not been selected and the elements that have been selected but do not form a pair (Figures 2-5 & Col 4:47-63). It would have been obvious for one of ordinary skill in the art at the time of invention to have utilized the animated pattern of Schneider et al in the invention of Moody et al in order to emphasize the winning combinations and play lines that contain these combinations.

Claims 21-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider et al (US 6,089,976) in view of Jackson et al (US 6,755,737).

Regarding at least claims 21 and 26, Schneider et al teaches a method for a game of chance on a gaming machine including receiving a wager from a player (*Schneider* Col 4:29-40), conducting a primary slot game based on the random reel outcome, starting a secondary selection game based on random tile placement responsive to a start-secondary game outcome in the primary game, and starting a primary game response to a start-primary game outcome in the secondary game (*Schneider* Figure 7). The start outcomes are understood as the qualifying outcome and the outcome of matching two rewards in the secondary game of Schneider. Schneider however teaches his secondary game and primary game in an opposite configuration wherein the slot game is the primary game and the selection game constitutes the secondary game. It would have been obvious to one of ordinary skill in

the art at the time of invention to have interchanged the primary slot game and secondary selection game of Schneider yielding a primary selection game and a secondary slot game in order create a game with a guaranteed percentage wager return and a chance at a jackpot prize. Schneider teaches a game outcome allowing the player to play a primary game subsequent to playing the secondary game however is silent regarding doing so without requiring a wager (Figure 7). In a related Invention Jackson et al describes the awarding of free base game plays in a bonus game on a gaming device with a first and second game (*Jackson Col 4:33-46*)..

It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the ability to win (qualify for) a free primary game as taught by Jackson in the secondary game of, in order to maintain a player's interest in utilizing the device as taught by Schneider (*Schneider Col 1:44-46*) or alternatively offer a game prize subject to the casino or gaming establishments recapture.

Regarding at least claims **22, 23, 27, and 28**, the combination of Schneider/Jackson teaches his previously secondary game as including interactive selection wherein the player selects an element and receives the award associated with the selection of an element prior to selecting at least one more element (*Schneider Col 2:65-3:16 & Figures 2-4*). As stated above the previously primary game of Schneider et al is understood as the secondary game of the applicant while the previously secondary game of Schneider et al is understood as the primary game of the applicant.

Regarding at least claims **24, 25, and 31**, and in addition to the above stated in the rejection of claims **21-23 and 26-28**, the combination of Schneider/Jackson teaches

the use of a slot reel game including a plurality of symbol bearing slot reels that are rotated and stopped to place a symbols on the reels in visual association with a display area in his previously primary game (*Schneider* Col 5:9-33 & Figure 1).

Regarding at least claims **29** and **30**. The combination of Schneider/Jackson teaches the step of conducting a primary slot game including awarding a payout based on the symbols displayed in the display area of a video display (*Schneider* Col 5:20-33 & Col 2:57-64).

### ***Response to Arguments***

Applicant's arguments filed August 16<sup>th</sup>, 2006 and with regards to claims **1, 3, 8-13, and 18-31** have been fully considered but they are not persuasive. The rejection presented above and directed to claims **1, 3, 8-9, 11, 13, and 18-19** has been appended to better address the newly presented claim language as it relates to the previously presented art of Moody.

On pages ten through eleven of the remarks by Applicant filed August 16<sup>th</sup>, 2006 the Applicant proposes the switch of the nomenclature in the claim to provide three perceived short comings of the prior art as presently applied, however this renaming of the components is improper for failing to include the features associated with those components (The Applicant has transposed the names of the first and second game without transposing the respective features of the slot and selection game). Specifically the Applicant's claims as presented sets forth the invention of Schneider with the primary game slot game of Schneider and the secondary selection game of Schneider

interchanged and according renamed to reflect that the original secondary game of Schneider would represent the primary selection game after the transposition while the original primary slot game of Schneider now reflects the secondary game after the transposition.

Juxtapose to transposition of games however the Applicant's exemplary claims as presented on page ten of the their remarks cited above merely relabeled their respective games primary and secondary games without any consideration of the features associated with the respective games. Accordingly in response to the Applicant's raised points of contention as present on page eleven of their remarks referenced above and directed to their exemplary claim, the following is (i) the wager would be associated with the play of the first or primary game regardless of which game constituted the first game played; (ii) the secondary game would again only be accessible through the first game again irregardless of which type of game constituted the second game, and; (iii) the enactment of the primary game without requiring a additional wager from the player has been addressed in the rejection previously presented and now maintained.

It is ultimately unclear on what basis the Applicant intends to challenge the motivations statement when the Applicant has not yet directly redressed the previously presented motivations in the rejection above.

Lastly the Applicant challenges that there is seemingly no motivation to make the modifications suggested yet the Applicant thus far seems to have excluded any objective evidence of support for their assertion.

***Allowable Subject Matter***

Claims 2, 4-7, 12, and 14-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 32, and 33 are allowed.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Frohm et al (USP 6,592,457) teaches a gaming device including a selection game.

Vancura (USP 6,033,307) teaches a gaming device including the use of a reeled slot machine

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hotaling can be reached on (571) 272-4437. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

REM



MARK SAGER  
PRIMARY EXAMINER